

Amendments to the Drawings:

The attached sheets of drawings includes changes to Figures 1-19. These sheets, which include Figures 1-18, replace the original sheets including Figures 1-18. In Figures 1-18, the figures have been label as "Related Art." In Figure 19, an arrowhead has been added to indicate the connection to the "Relational" device.

Attachment: Replacement Sheets

 Annotated Sheets Showing Changes

REMARKS

Claims 1-49 are pending in the application, and that claims 28-33, 38-40 and 44-49 have been withdrawn from consideration. The Examiner rejected claims 1-27, 34-37, and 41-43 under 35 U.S.C. § 102(a). The Examiner's rejections are traversed below.

Objection to Drawings

In the Office Action the Examiner objected to the drawings, stating that arrowhead on the "Relational" device in Figure 19 is missing. Figure 19 is hereby amended to show the correct connection to the "Relational" device.

The Examiner also requested that Figures 1-18 be labeled as prior art in light of U.S. Patent No. 6,246,975 and Sumner II et al., "Simulating Patients with Parallel Health State Networks," Proceedings of the American Medical Informatics Association Annual Symposium, p. 438-442, (1998) (hereafter "the AMIA reference").

Figures 1-18 are not prior art because the present Application and U.S. Patent No. 6,246,975 were, at the time the inventions were made, commonly owned by The American Board of Family Practice, Inc. Since the figures do not, in themselves, describe the "invention" nor the "subject matter that is sought to be patented," the fact that the figures are present in an previously filed and granted patent does not render Figures 1-18 in the present application as anticipated under §102 or obvious under §103. In addition, the AMIA reference as shown below is not available as a prior art reference. However, so as to avoid any confusion between Figures 1-18 in the present application and the figures in U.S. Patent No. 6,246,975, Applicant hereby resubmits Figures 1-18 with the designation "Related Art." Applicant is in the process of obtaining formal drawings to formalize the above corrections.

Rejection Under 35 U.S.C. § 102(a)

Claims 1-27, 34-37, and 41-43 stand rejected under 35 U.S.C. §102(a) as being anticipated by the AMIA reference. Applicants respectfully traverse this rejection.

The AMIA reference is ineligible to be used as §102(a) reference against the present application. 35 U.S.C. § 102(a) provides that:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

The AMIA reference was not “known or used by others...before the invention thereof by the applicant for patent.” As stated in the “Declaration of Walton Sumner II, M.D. and Michael D. Hagen, M.D. Under 37 C.F.R. § 1.132” submitted on May 6, 2003, the co-authors of the AMIA reference, Miroslaw Truszcynski, Ph.D. and Victor W. Marek, Ph.D., were not “inventors” of the subject matter described in the AMIA article. The co-authors were named “for their technical assistance to the work,” and “they did not contribute to the conception of the method claimed in the [present] Application and, thus, are not named as co-inventors of the [present] Application.”

In addition to the declaration of Applicants, the co-authors of the AMIA reference, Drs. Truszcynski and Marek, have also executed a declaration, which is filed herewith. Their declaration states that they “did not conceive of the work described” in the AMIA reference, but, rather, “were supervised by the Applicants and performed this work under their direction.” Drs. Truszcynski and Marek, as noted in their declaration, “were named co-authors...for [their] technical assistance to the work and [they] did not contribute to the conception of the methods claimed in the Application and, thus, are not named as co-inventors of the Application.”

The Federal Circuit in In re Katz, stated that "authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. The content and nature of the printed publication, as well as the circumstances surrounding its publication, not merely its authorship, must be considered." 687 F.2d 450, 455, 215 USPQ 14, 18 (Fed. Cir. 1982). The Federal Circuit held that, "what is required is a reasonable showing supporting the basis for the applicant's position." 687 F.2d at 455, 215 USPQ at 18. "In the declaration, appellant provides the explanation that the co-authors of the publication... 'were students working under the direction and supervision of the inventor.' This statement is of significance since it provides a clear alternative conclusion to the board's inference that their names were on the article because they were co-inventors. ...On the record here, the board should not have engaged in further speculation as to whether appellant's view was shared by his co-authors but rather should have accepted that [the co-authors] were acting in the capacity indicated." 687 F.2d at 455-456, 215 USPQ at 18.

The declarations of the Applicants and of the co-authors is clearly sufficient to support the conclusion that the co-authors are not co-inventors of the subject matter claimed in the present application. This situation is analogous to that of Katz and as such, the AMIA article is not properly cited as prior art. Withdrawal of the rejection of claims 1-27, 34-37, and 41-43 under 35 U.S.C. § 102(a) is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn. Issuance of a Notice of Allowance is respectfully requested.

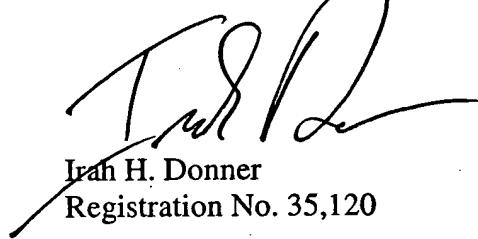
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for this Amendment, or credit any overpayment to deposit account no. 80-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 80-0219.

Respectfully submitted,

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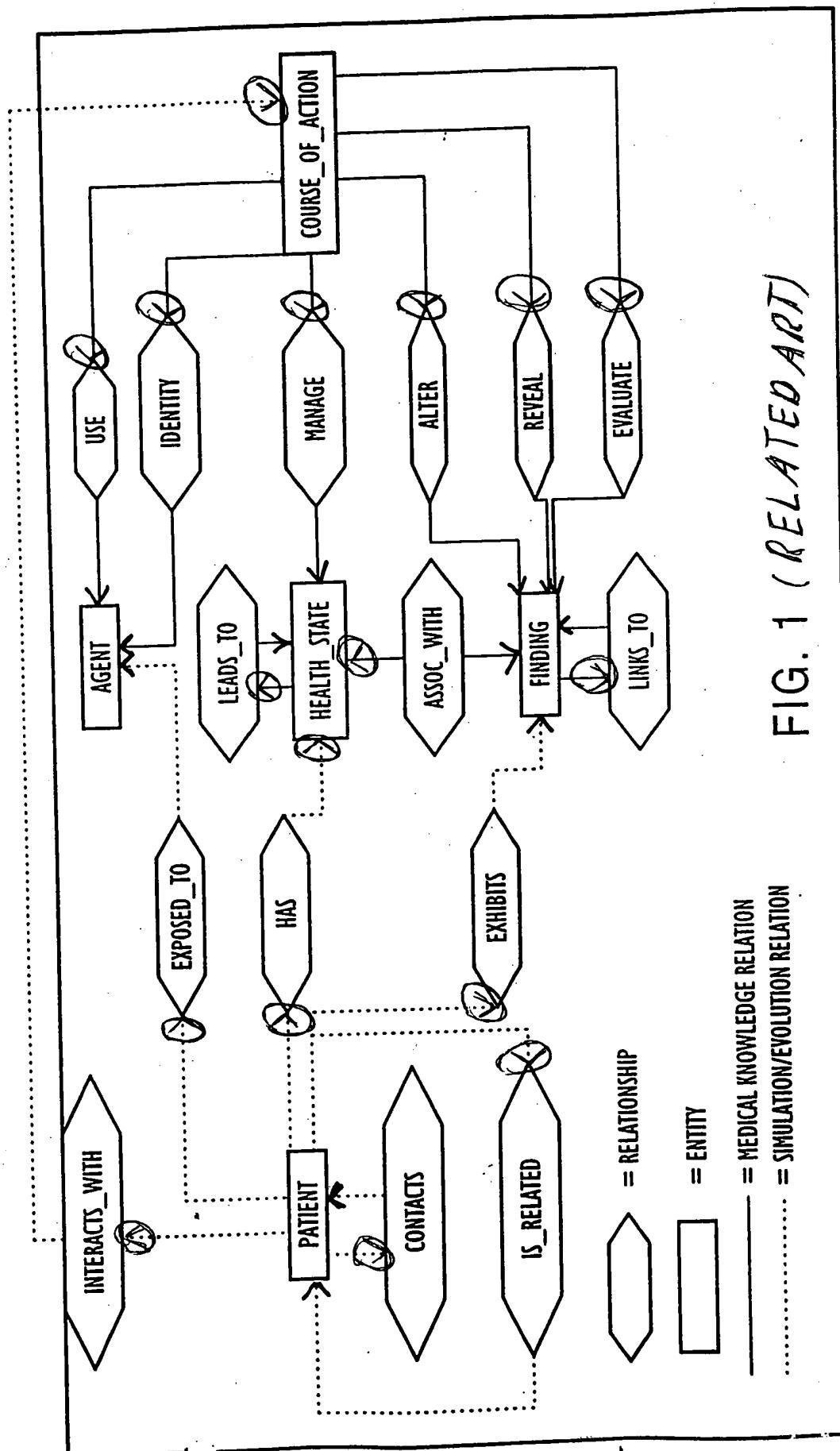


FIG. 1 (RELATED ART)

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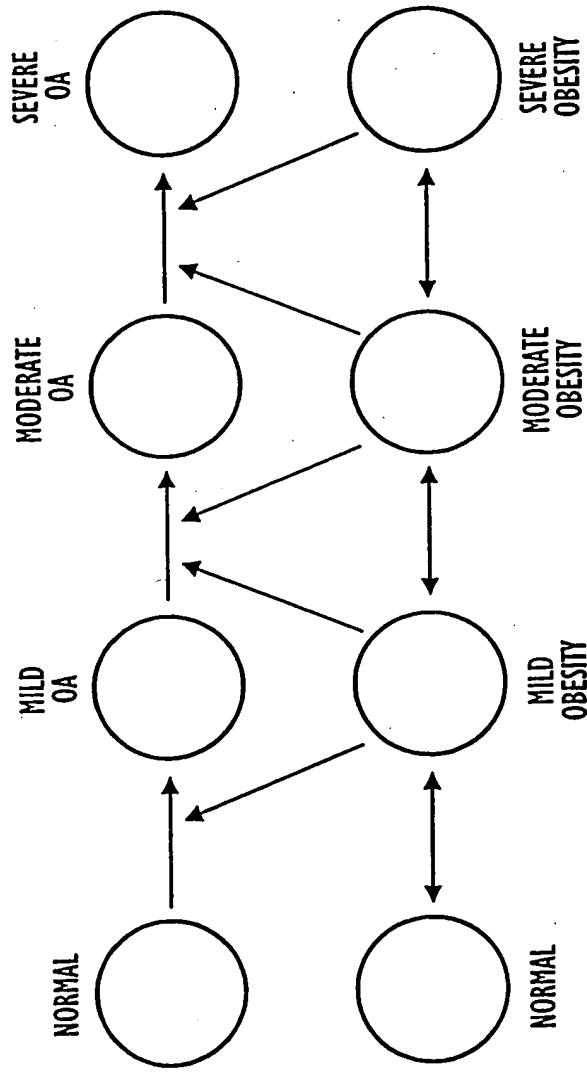


FIG. 2

(RECEIVED ART)

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Appl. No. 09/521,242
Annotated Sheet Showing Changes

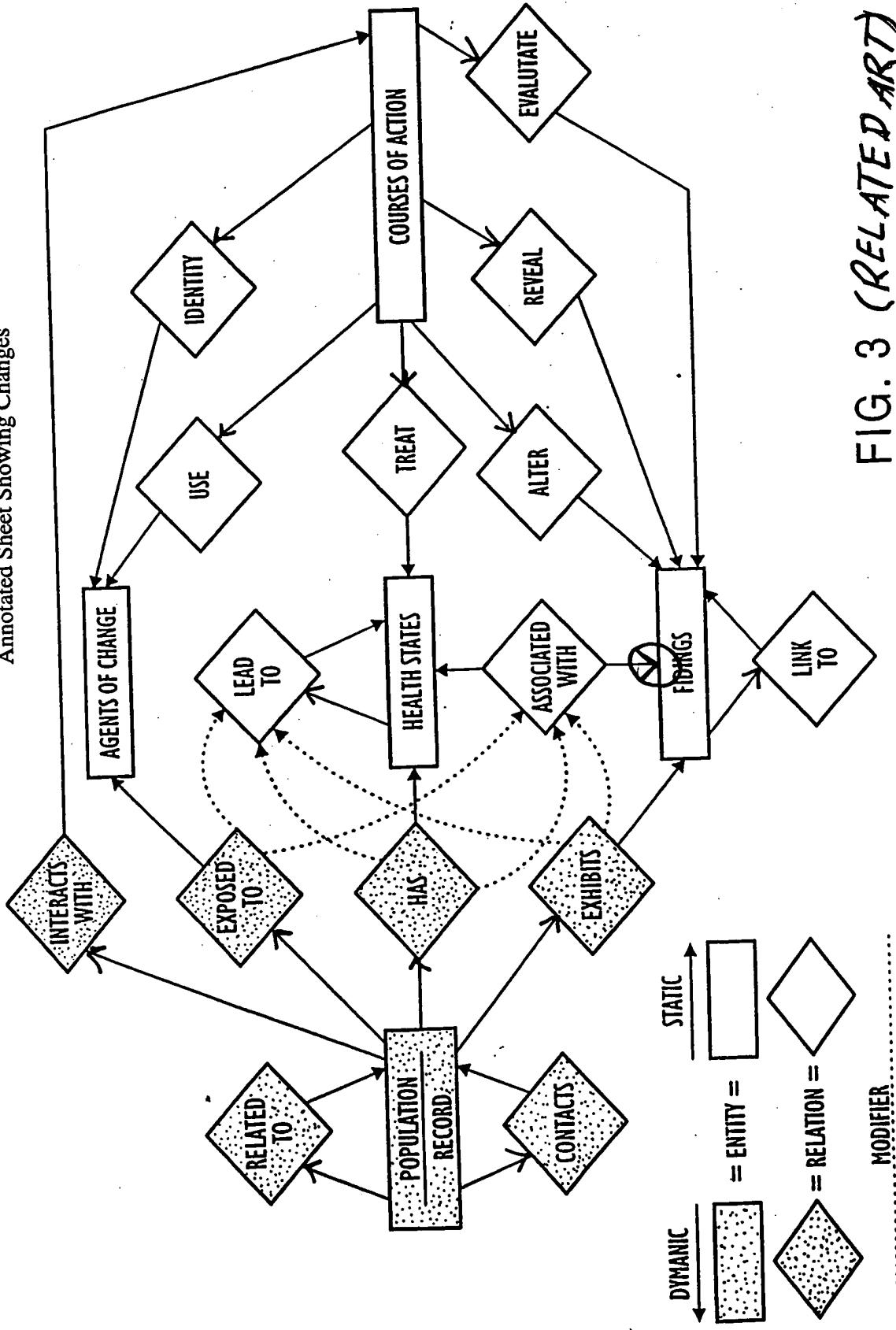


FIG. 3 (RELATED PART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

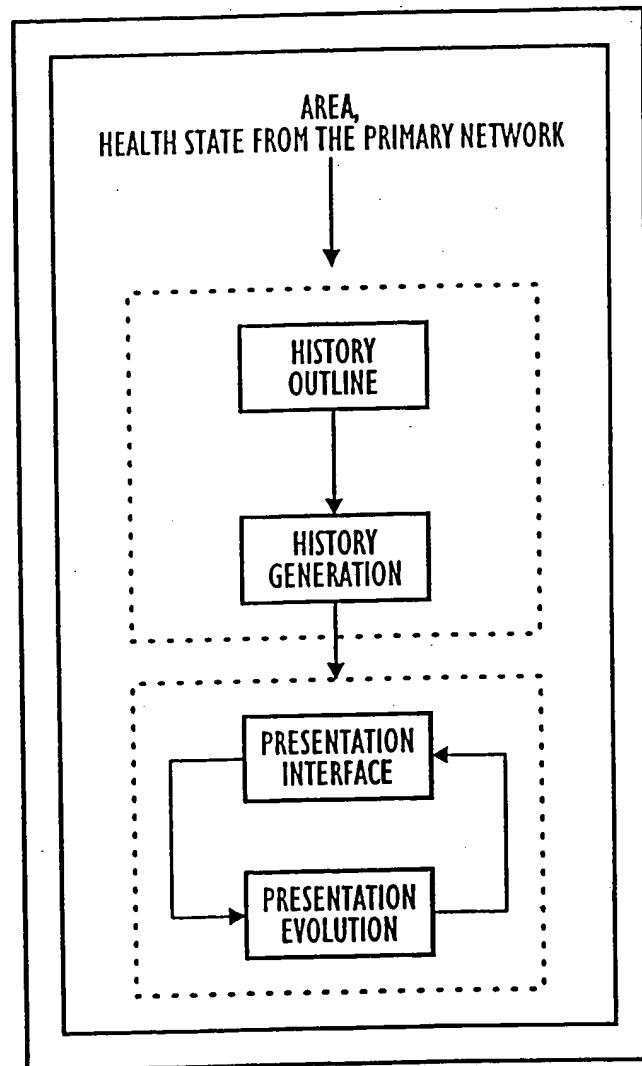


FIG. 4
(RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

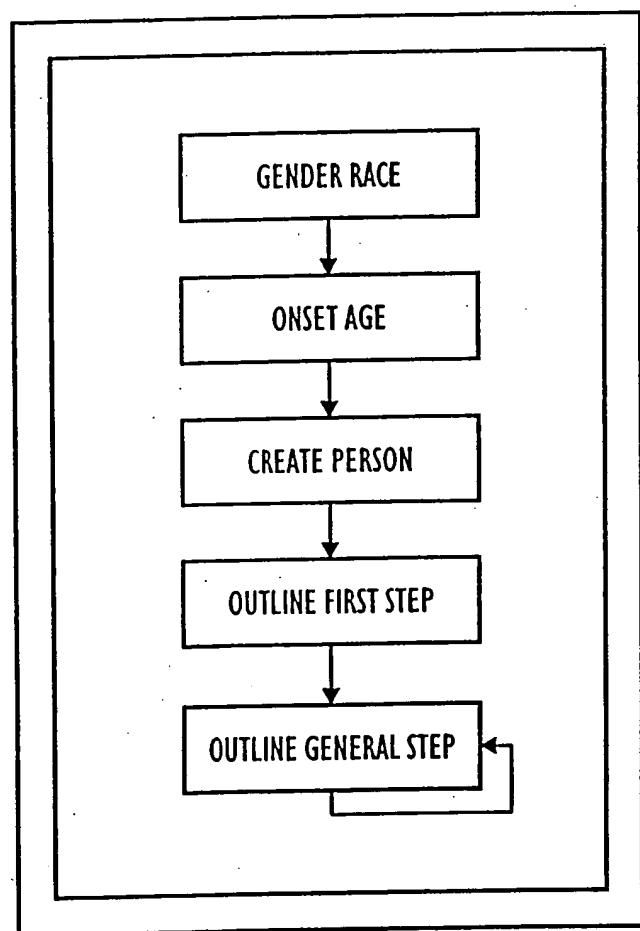


FIG. 5
(RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

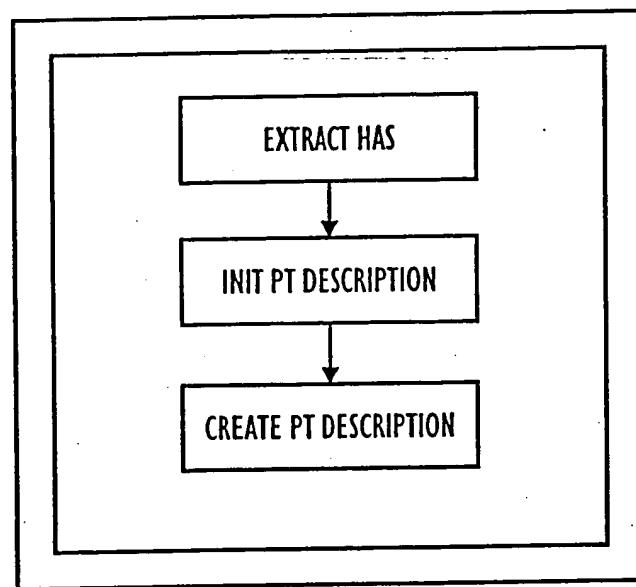


FIG. 6
(RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

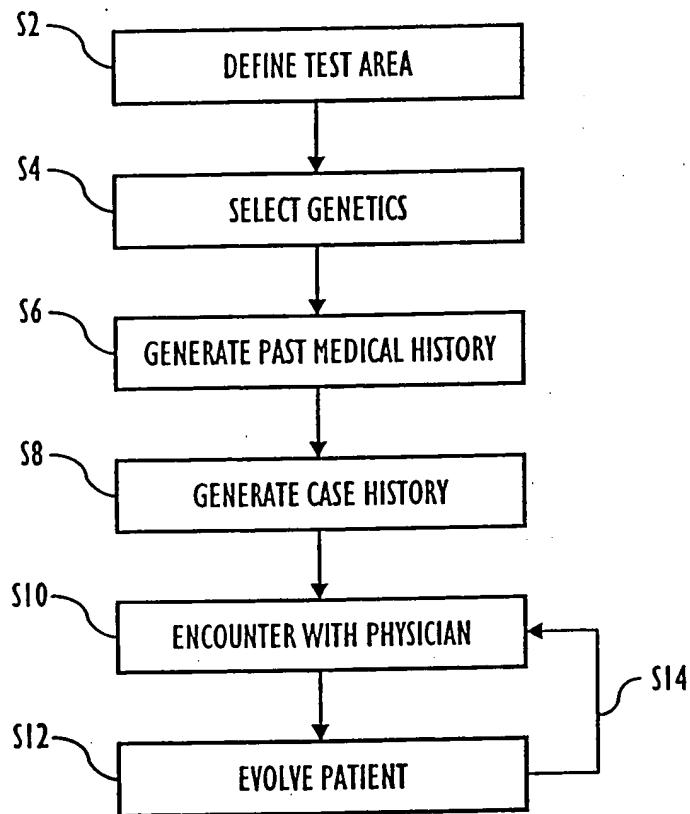


FIG. 7
(RELATED ART)

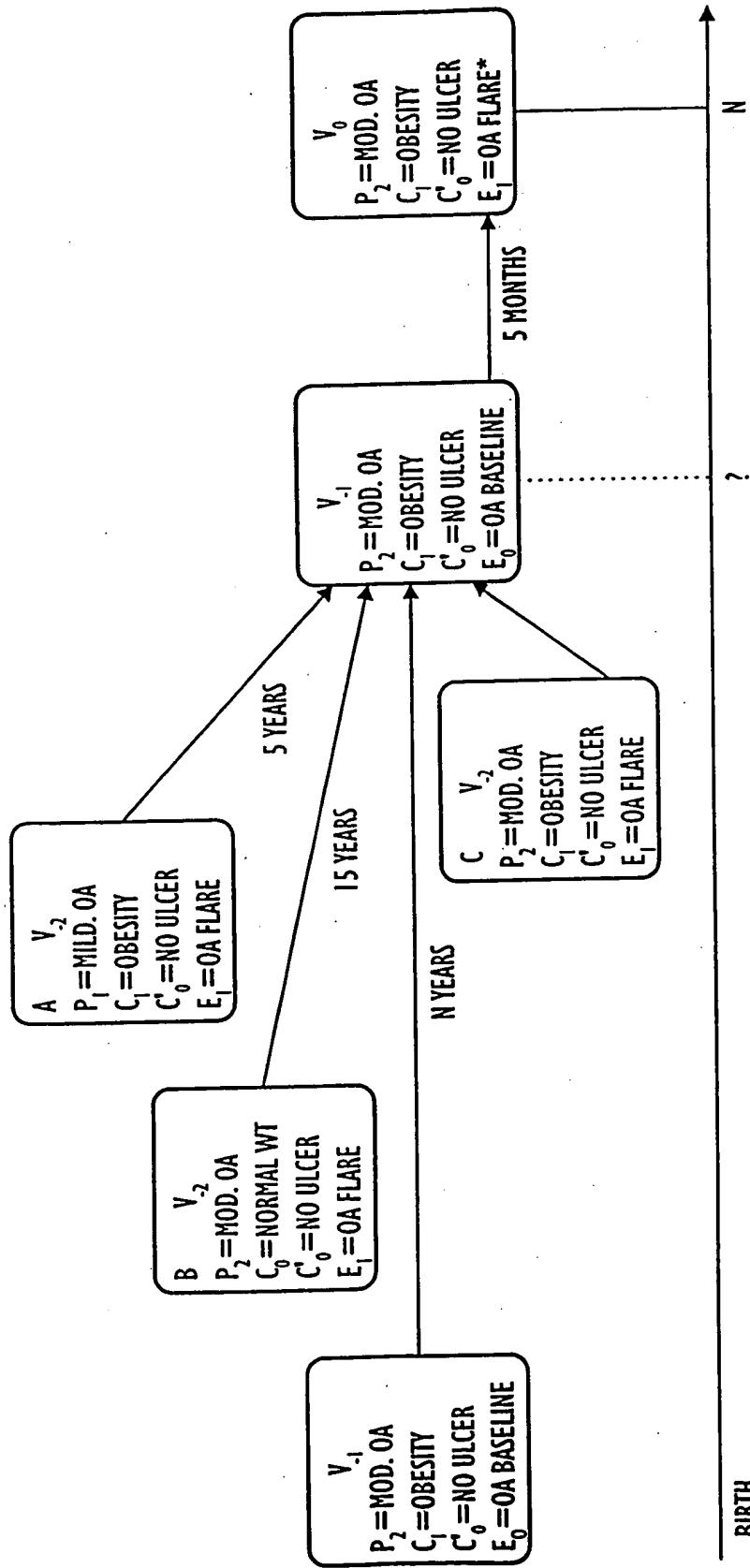


FIG. 8
(ELATED AET)

Appl. No. 09/521,242
 Annotated Sheet Showing Changes

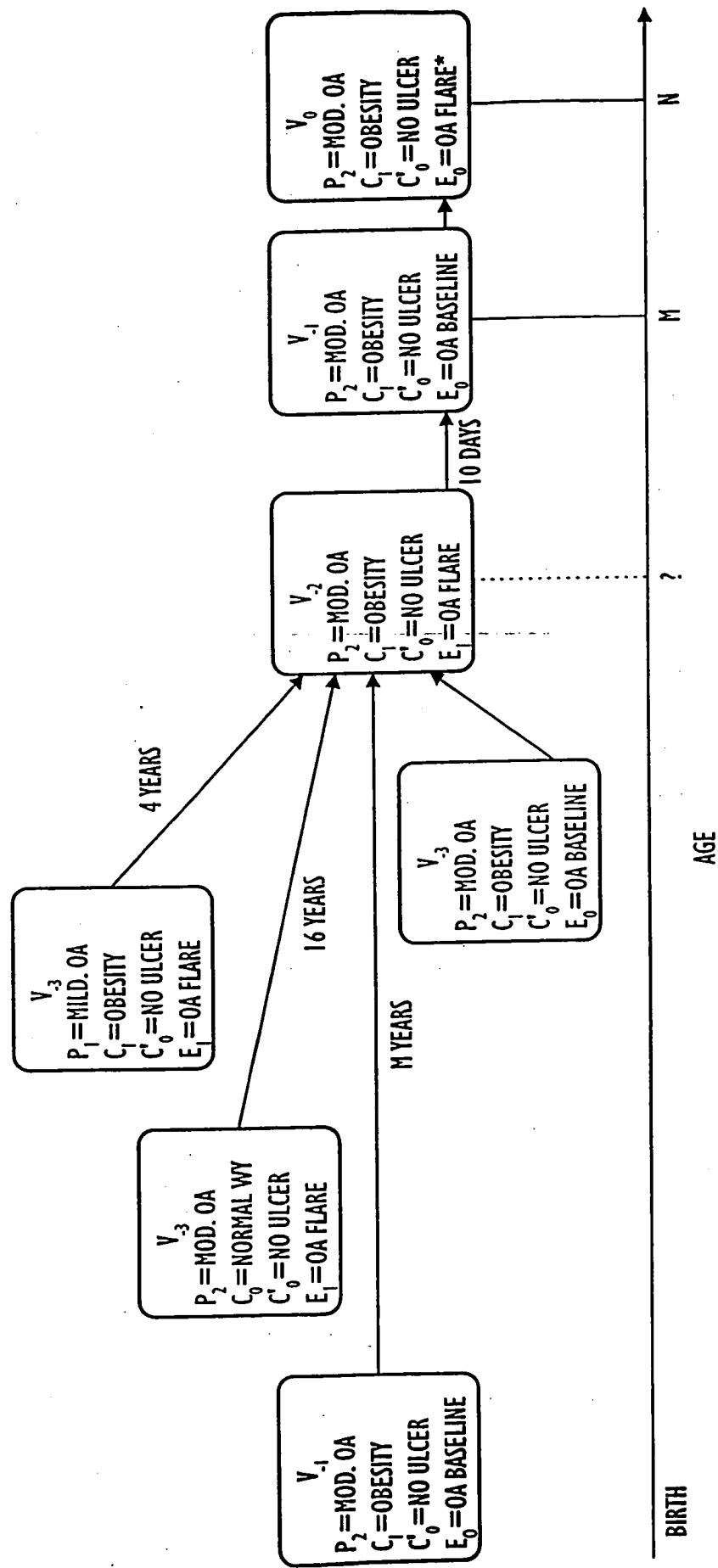


FIG. 9
(RELATED ACT)

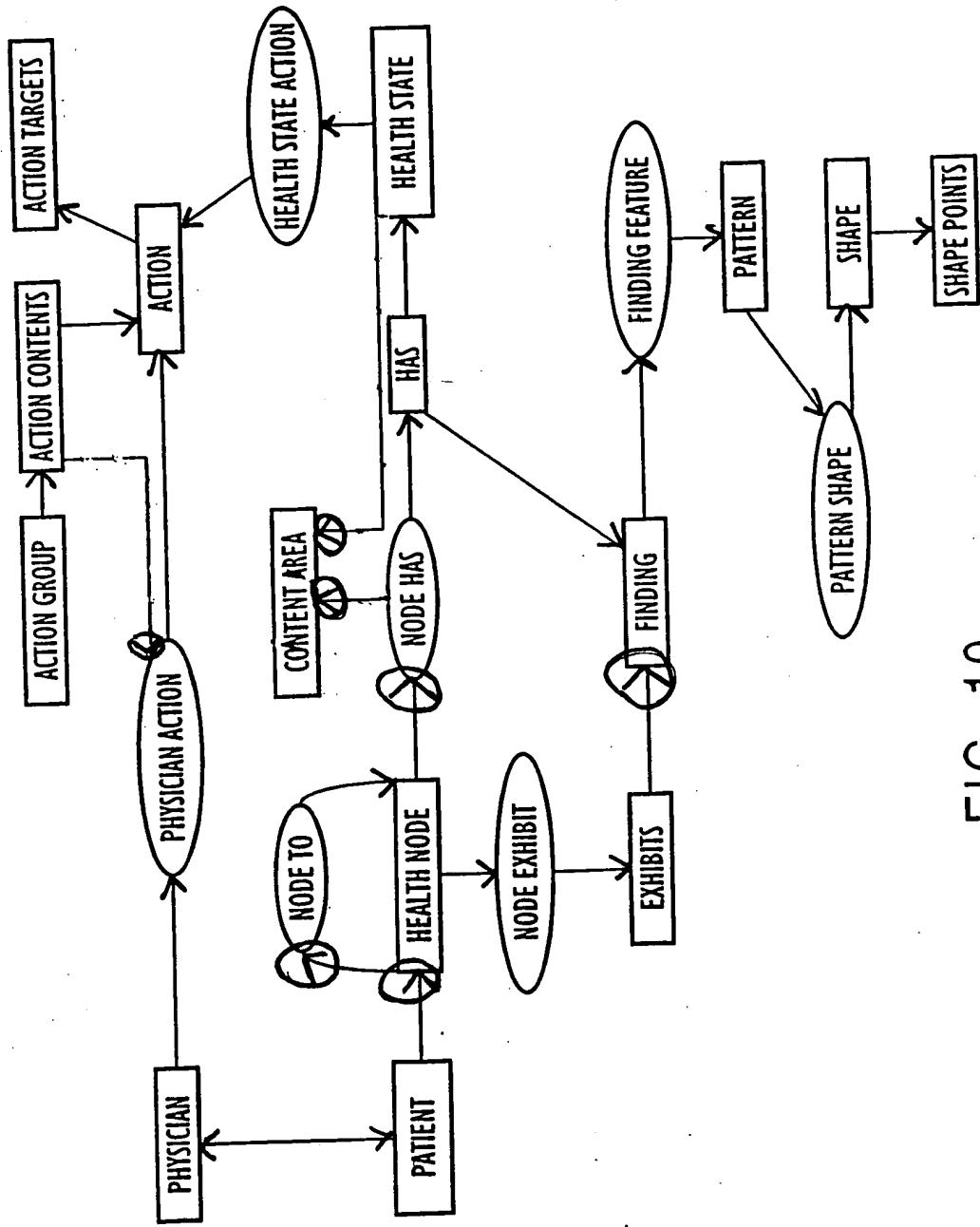


FIG. 10
 (RELATED ALT)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

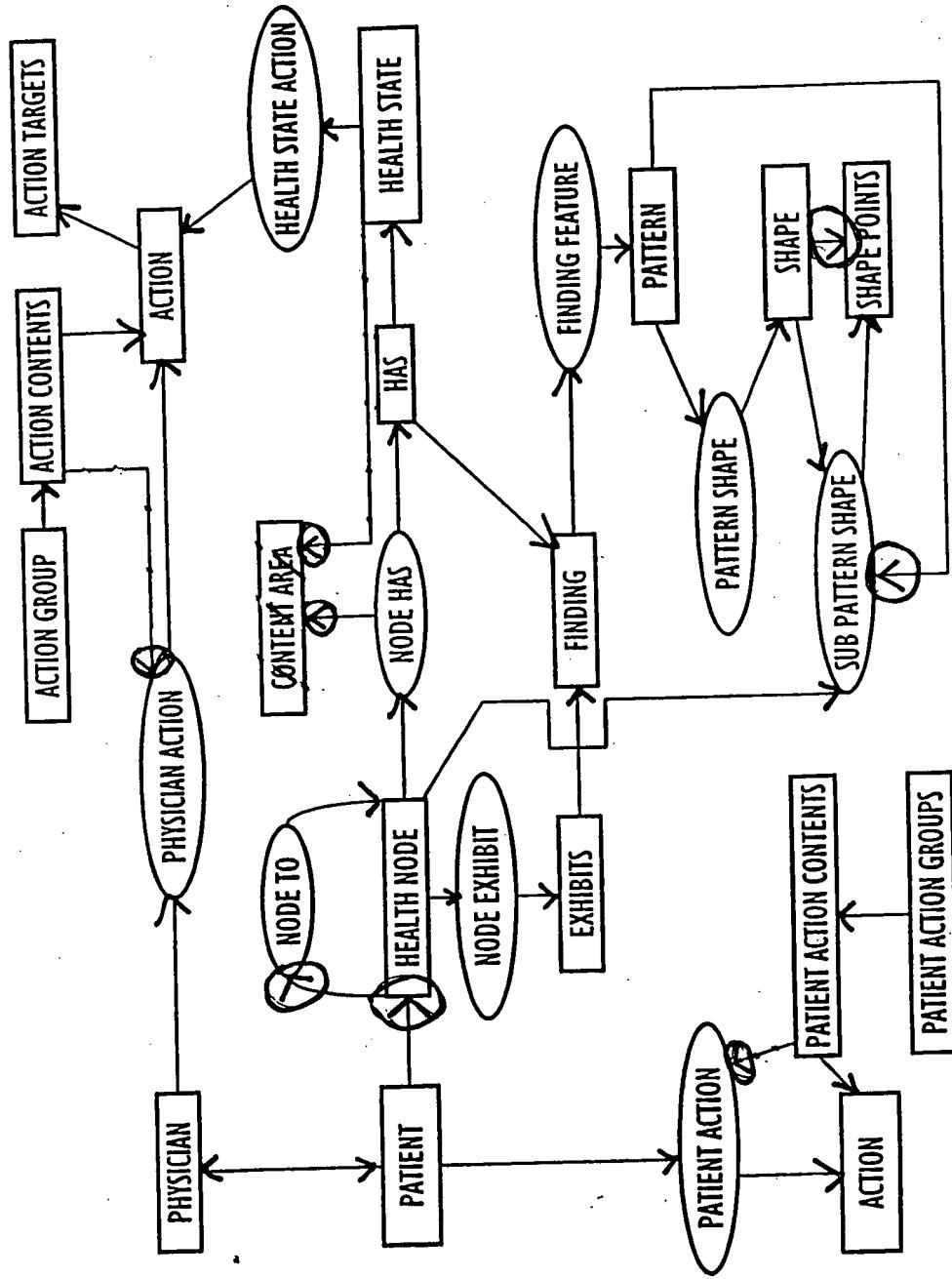


FIG. 11
(RELATED ART)

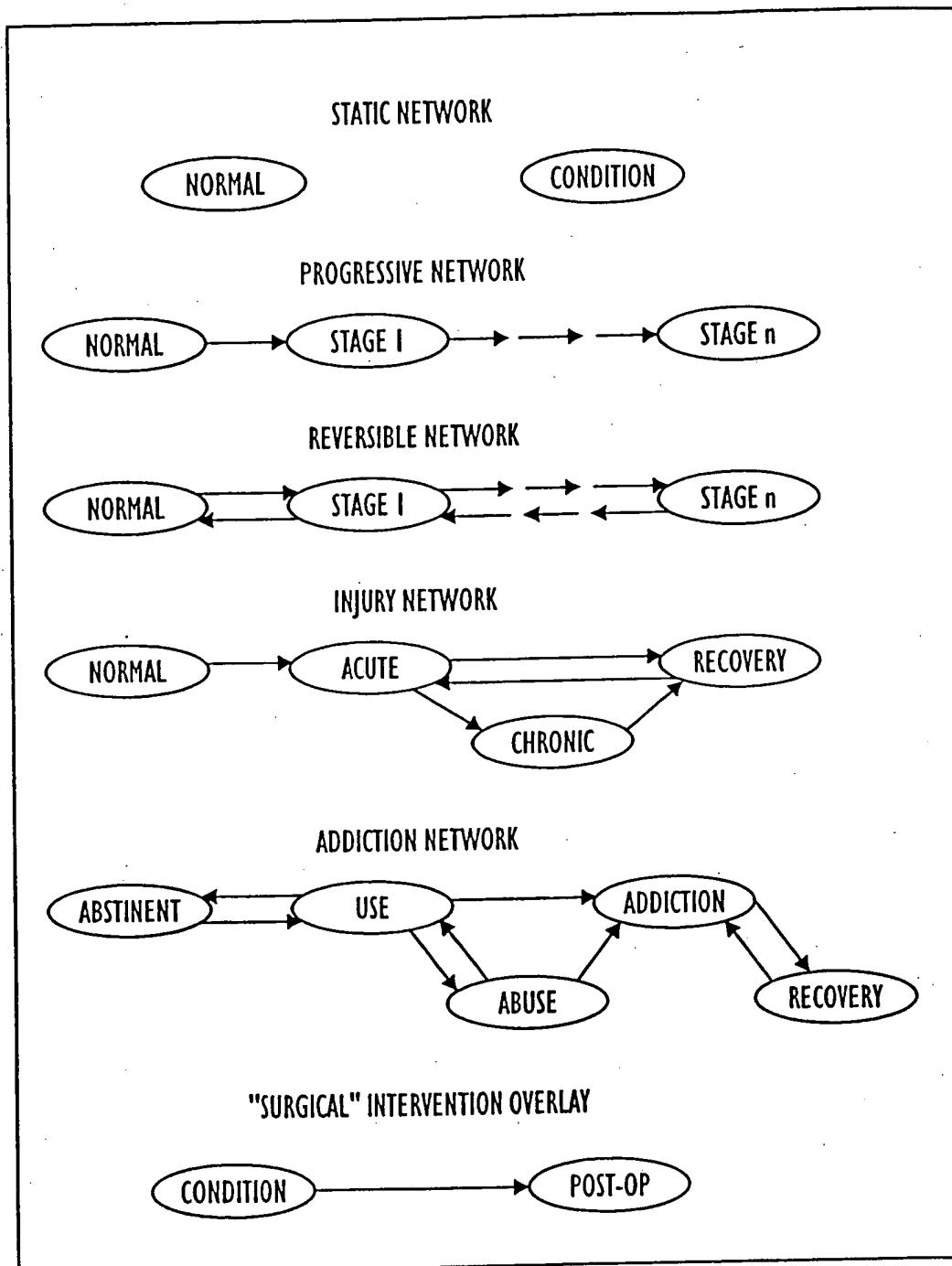


FIG. 12
(RELATED ART)

Appl. No. 09/521,242
 Annotated Sheet Showing Changes

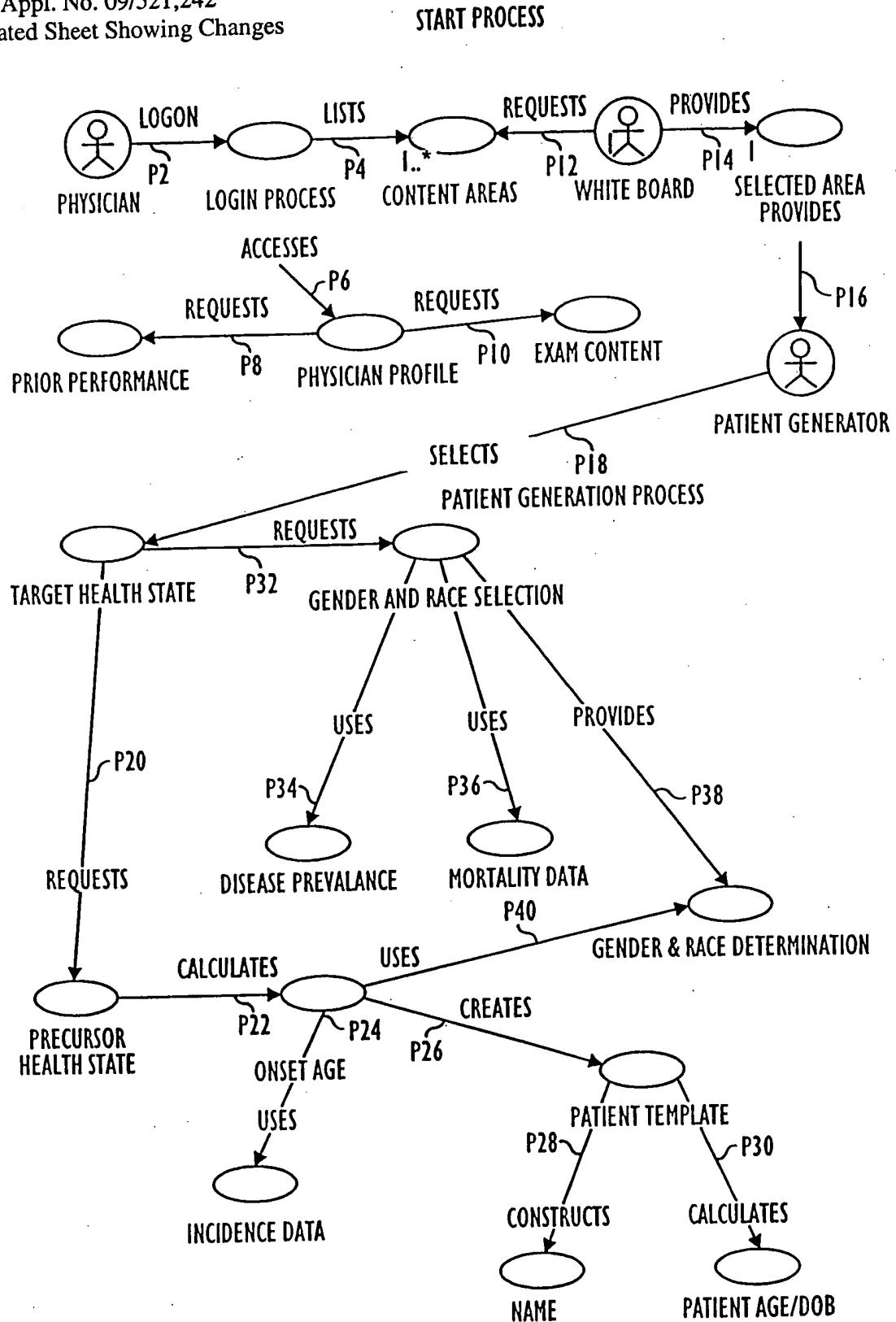


FIG. 13 (RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

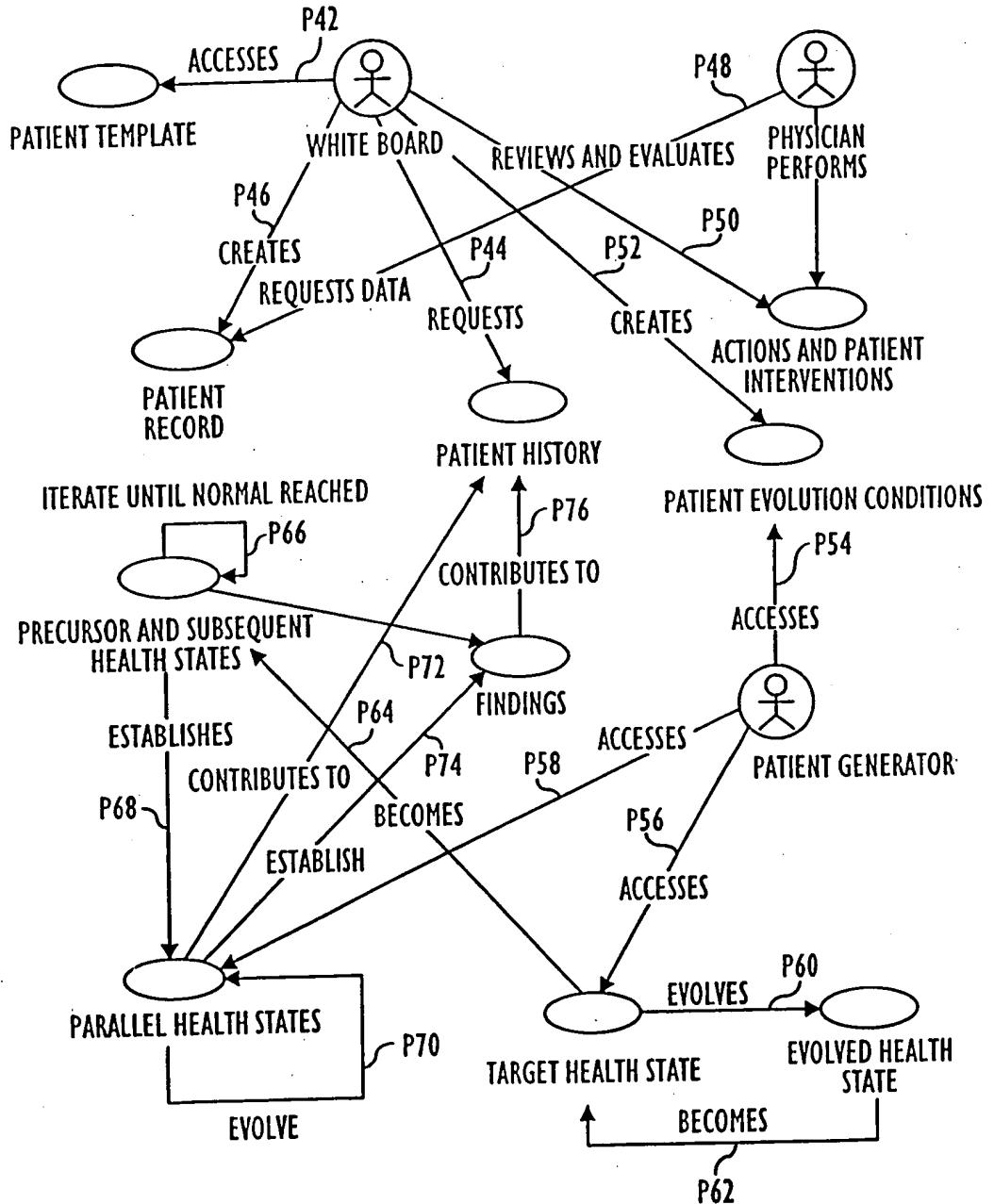


FIG. 14
(RELATED ART)

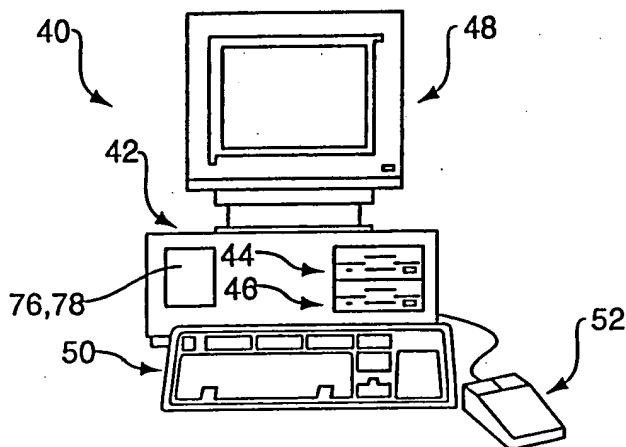


FIG. 15
(RELATED ART)

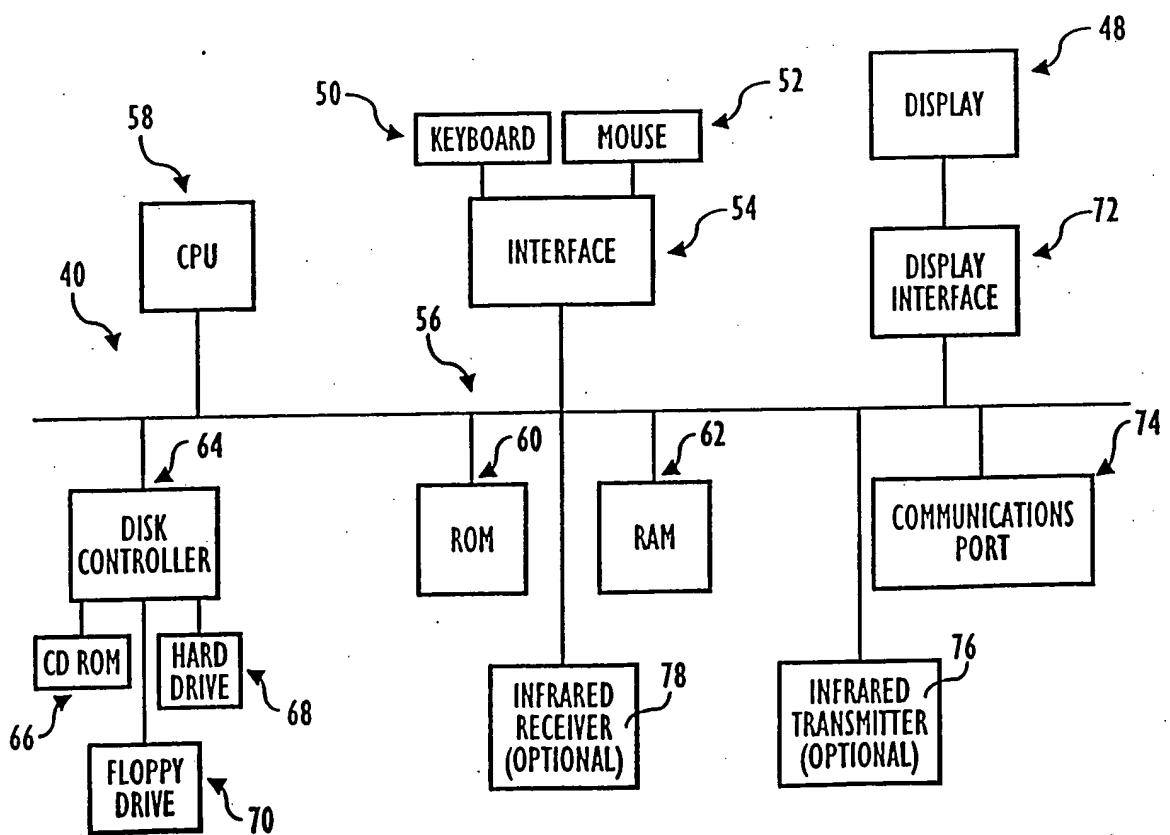


FIG. 16 (RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

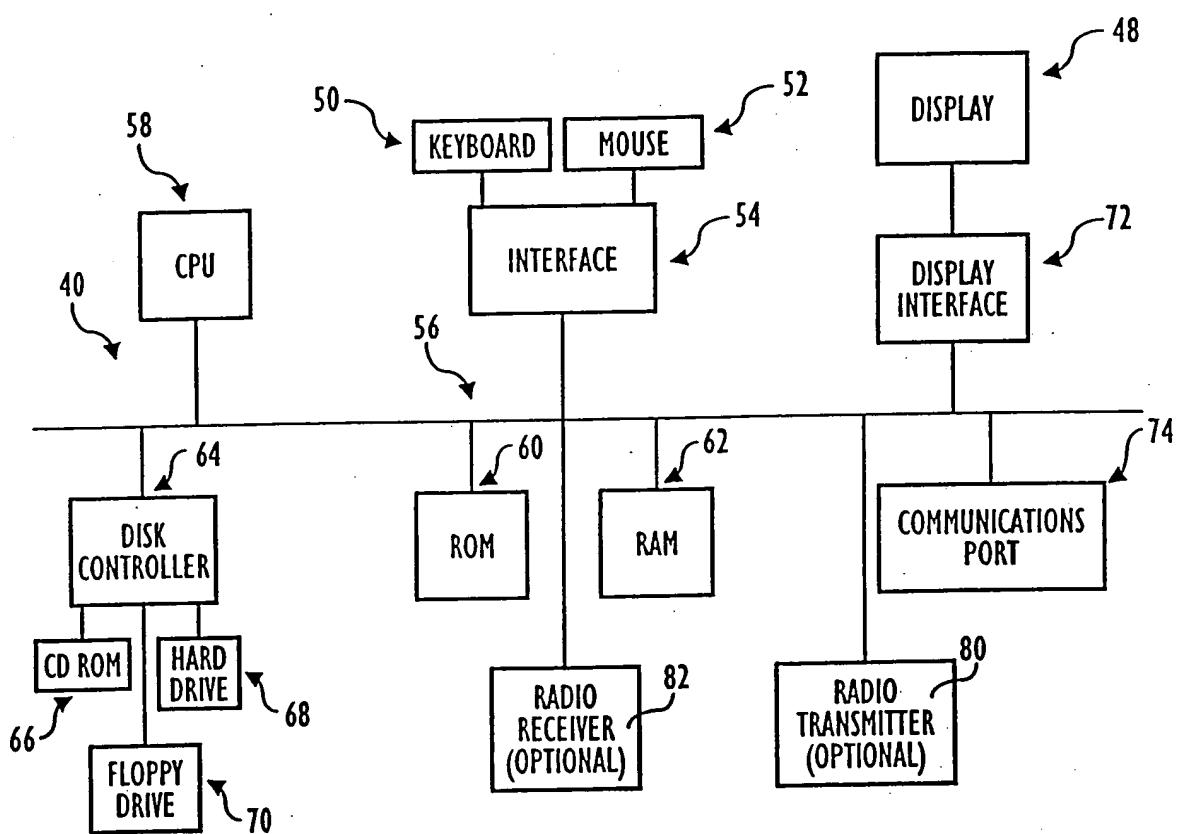


FIG. 17
(RELATED ART)

Appl. No. 09/521,242
Annotated Sheet Showing Changes

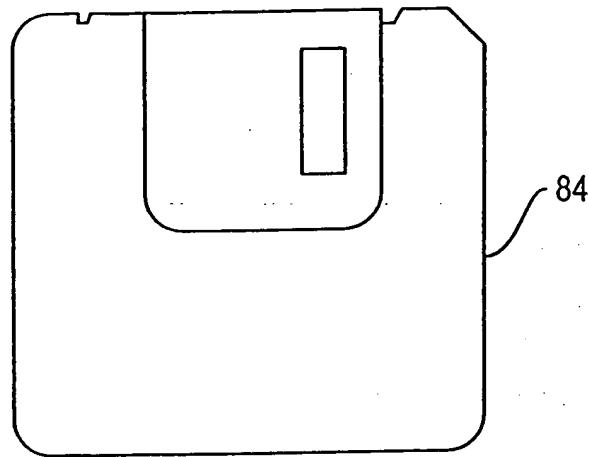
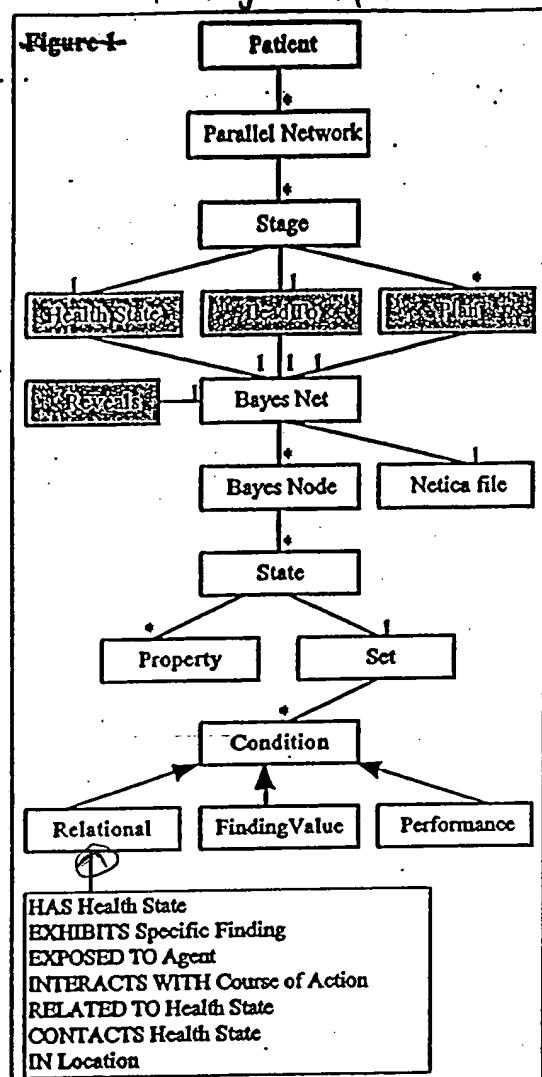


FIG. 18
(RELATED ART)

Figure 19



(RELATED ART)